

REMARKS

This Application has been carefully reviewed in light of the final Office Action mailed February 27, 2001. In the Office Action, the Examiner finally rejected Claims 1-57. In order to advance prosecution of this application, Claims 1, 25 and 51 are amended, and Claims 52 and 55 are canceled. Thus, Claims 1-51, 53-54 and 56-57 are now pending in this Application. Applicants respectfully request reconsideration and favorable action in this case.

Amendments to the Claims

Claim 1 is amended to add the elements of dependent Claim 52 which has been canceled, and Claim 25 is amended to add the elements of dependent Claim 55 which has been canceled. Claim 51 is also amended to add the elements of Claims 52 and 55. Accordingly, no new matter is added by these amendments. Applicants respectfully request that these amendments after final be entered because they put the claims in better condition for appeal and do not require a new search. That is, the elements have been previously presented in the canceled dependent claims.

Section 102 Rejections

The Examiner rejected pending Claims 1-3, 7, 14-21, 23, 25-27, 31, 36-43, 45 and 47-50 under 35 U.S.C. §102(b) as being anticipated by European Patent No. 0 511 463 A2 issued to Greer (*Greer*). Of these, Claims 1 and 25 are independent. Applicants respectfully traverse these rejections for the reasons discussed below.

In the final Office Action, the Examiner failed to address the previous amendments to independent Claims 1 and 25, which resulted in these claims positively reciting that the discount triggering items are associated with a pre-determined redeemable item. Thus, Applicants once again respectfully submit that *Greer* fails to disclose this element of the independent claims.

Greer provides for applying a discount generated at a first visit to the store to a customer's order during a subsequent visit to the store. Col. 8, lines 22-36. *Greer* fails to disclose that the discount is to be applied to a pre-determined redeemable item, but appears to teach that the discount may be applied to any customer order on a subsequent visit. Col. 8, lines 22-36. Thus, the customer simply receives a delayed discount based on purchasing a specific product. When the customer returns to the store, the discount is applied to the customer's purchase in the same way as a typical coupon discount, *i.e.*, the discount is simply applied to the customer's total purchase. Thus, *Greer's* system benefits only two entities: the store and the manufacturer of the specific product. Col. 9, lines 1-28.

In contrast, the present invention provides for discount triggering items to be associated with a pre-determined redeemable item. This element of the present invention which is missing in *Greer* provides an advantage by giving a customer incentive to purchase multiple products at multiple locations. Thus, the present invention benefits four different entities instead of the two benefited by *Greer's* system. By associating discount triggering items at an initial vendor with a pre-determined redeemable item at a subsequent vendor, the present invention results in a customer's being given incentive (i) to purchase the discount triggering items (ii) from the initial vendor and (iii) to purchase the pre-determined redeemable item (iv) from the subsequent vendor. Thus, both the initial vendor and the subsequent vendor benefit, as well as the manufacturers of both the discount triggering items and the pre-determined redeemable item. Therefore, *Greer* fails to teach all elements of amended Claim 1. Accordingly, Claim 1 is not anticipated by the cited art.

In the final Office Action, the Examiner interpreted the initial vendor and the subsequent vendor as being the same vendor. Office Action, page 6. Thus, Claim 1 is now amended to positively recite "the subsequent vendor distinct from the initial vendor." Applicants respectfully submit that *Greer* fails to disclose, teach or suggest this element. In fact, *Greer* teaches away from this element. *Greer* discloses that an advantage of its system is that "large numbers of customers are involved and given incentive to return to the store." Col. 9, lines 17-19 (emphasis added). Thus, *Greer* cannot be modified as suggested by the Examiner, as any such modification would destroy the functionality of the system by eliminating the stated advantage of giving a customer incentive to return to the same store to redeem the certificate.

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art . . . 'All words in a claim must be considered in judging the patentability of that claim against the prior art.'" MPEP § 2143.03 (emphasis added), quoting *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). No suggestion can be found in *Greer* for generating a redemption value that represents "a discount available for use in a subsequent purchase transaction at a subsequent vendor, the subsequent vendor distinct from the initial vendor," because *Greer* teaches away from this element. Therefore, in addition to there being no suggestion to modify the art, the art teaches away from the claimed invention and all elements of the claimed invention are not taught or suggested by the art. Accordingly, for all these reasons, Claim 1 is allowable over the cited art. Therefore, Applicants respectfully submit that this rejection should now be withdrawn.

Similar to Claim 1, independent Claim 25, as amended, recites "identifying means for identifying discount triggering items in an initial purchase transaction at an initial vendor, the discount triggering items associated with a pre-determined redeemable item," and "output means for generating the redemption value for the pre-determined redeemable item based on the bundle totals, the redemption value representing a discount available for use in a subsequent purchase transaction at a subsequent vendor, the subsequent vendor distinct from the initial vendor, the subsequent purchase transaction comprising the pre-determined redeemable item." Accordingly, for the reasons discussed above in connection with Claim 1, Claim 25, as amended, is also not anticipated by the cited art. Therefore, Applicants respectfully submit that this rejection should now be withdrawn.

In addition, Applicants respectfully traverse the Examiner's Official Notice regarding the subsequent vendor and the initial vendor with respect to dependent Claims 52 and 55, which have been incorporated into Claims 1 and 25, respectively. Applicants disagree with the assertion that this element is old and well-known in the art. Thus, to the extent that this rejection is maintained by the Examiner and based on "Official Notice," "well-known art," common knowledge, or other information within the Examiner's personal knowledge, Applicants respectfully request that the Examiner cite a reference in support of his position or provide an affidavit in accordance with M.P.E.P. § 2144.03 and 37 C.F.R. § 1.107.

Dependent Claims 2, 3, 7, 14-21, 23, 47 and 48 that depend from independent Claim 1 and dependent Claims 26, 27, 31, 36-43, 45, 49 and 50 that depend from independent

Claim 25 are also not anticipated by the cited art because they include the limitations of their respective base claims and add additional elements that further distinguish the art. Therefore, Applicants respectfully submit that these rejections should now be withdrawn.

Section 103 Rejections

The Examiner rejected pending Claims 4-6, 8-13, 22, 24, 28-30, 32-35, 44, 46 and 51-57 under 35 U.S.C. §103(a). Claims 22, 44 and 51 were rejected as being unpatentable over *Greer*. Claims 4, 5, 28 and 29 were rejected as being unpatentable over *Greer* in view of U.S. Patent No. 5,612,868 issued to Off, et al. (*Off*). Claims 6 and 30 were rejected as being unpatentable over *Greer* in view of U.S. Patent No. 4,723,212 issued to Mindrum, et al. (*Mindrum*). Claims 8, 9, 32 and 33 were rejected as being unpatentable over *Greer* in view of U.S. Patent No. 5,481,094 issued to Suda (*Suda*). Claims 10-13, 24, 34, 35 and 46 were rejected as being unpatentable over *Greer* in view of U.S. Patent No. 5,380,991 issued to Valencia, et al. (*Valencia*). Claims 52-57 were rejected as being unpatentable over *Greer*. Of these, Claim 51 is independent. Claims 52 and 55 have been canceled. Applicants respectfully traverse these rejections for the reasons discussed below.

Claims 4-6, 8-13, 22, 24 and 53-54 depend from independent Claim 1, and Claims 28-30, 32-35, 44, 46 and 56-57 depend from independent Claim 25. As discussed above in connection with the § 102 rejections, Claims 1 and 25 are patentable over the cited art. Therefore, Claims 4-6, 8-13, 22, 24, 28-30, 32-35, 44, 46, 53-54 and 56-57 are patentable over the art because they include the elements of their respective base claims and add additional elements that further distinguish the art.

In particular, Claims 53 and 56 each recite "the initial vendor comprising a grocery store and the subsequent vendor comprising a gas station." *Greer* fails to disclose any type of certificate or coupon which is generated at one vendor to be redeemed at another vendor. Thus, *Greer* necessarily also fails to disclose generating a certificate at a grocery store for redemption at a gas station. Thus, for this reason also, Claims 53 and 56 are allowable.

Claims 54 and 57 each recite "the pre-determined redeemable item comprising fuel." As discussed above in connection with Claim 1, *Greer* fails to disclose a redemption value associated with a pre-determined redeemable item. Thus, *Greer* necessarily also fails to disclose generating a certificate representative of a discount available for use in a subsequent

purchase of fuel. Thus, for this reason also, Claims 54 and 57 are allowable. Accordingly, Applicants respectfully submit that these rejections should now be withdrawn.

Similar to Claim 1, independent Claim 51, as amended, recites "identifying credit triggering items in an initial purchase transaction at an initial vendor, the discount triggering items associated with a pre-determined redeemable item" and "generating the redemption value for the pre-determined redeemable item based on the bundle totals, the redemption value representing a credit available for use in a subsequent purchase transaction at a subsequent vendor, the subsequent vendor distinct from the initial vendor, the subsequent purchase transaction comprising the pre-determined redeemable item." Accordingly, for the reasons discussed above in connection with Claim 1, Claim 51, as amended, is patentable over the cited art. Therefore, Applicants respectfully submit that this rejection should now be withdrawn.

CONCLUSION


Applicants have now made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending Claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

The Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicants


Tara D. Knapp
Reg. No. 43,723